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In re application of : Thomas THORÖE SCHERB et al.

Examining Group. 1731

Attorney Docket No. P20418

Application No. : 09/769,462

Group Art Unit : 1731

Filed : January 26, 2001

Examiner : P. Chin

For : MACHINE AND PROCESS FOR PRODUCING A TISSUE WEB

Mail Stop Amendment

Commissioner for Patents

U.S. Patent and Trademark Office

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Sir:

Transmitted herewith is a **Reply Brief Under 37 C.F.R. 1.193(b)(1)** (in triplicate) in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ A Request for Extension of Time.

☒ A Request for Oral Hearing.

☐ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 52	*54	0	x 9=	\$	x 18=	\$ 0.00
Indep. Claims: 3	**3	0	x 44=	\$	x 88=	\$ 0.00
Multiple Dependent Claims Presented			+150=	\$	+300=	\$ 0.00
Request for Oral Hearing Filing Fee				\$		\$300.00
Total:				\$	Total:	\$300.00

* If less than 20, write 20

** If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

☒ A check in the amount of \$300.00 to cover the filing fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

[Signature]
Neil F. Greenblum

Reg. No. 28,394 *155,043*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants : Thomas THORÖE SCHERB et al. Confirmation No.: 5458
Appln. No. : 09/769,462 Group Art Unit: 1731
Filed : January 26, 2001 Examiner: P. Chin
For : MACHINE AND PROCESS FOR PRODUCING A TISSUE WEB

**REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is in response to the Examiner's Answer dated August 10, 2004, the period for reply extending until October 12, 2004 (October 10, 2004 being a Sunday and October 11, 2004 being a U.S. Federal holiday).

In the Examiner's Answer, the Examiner has maintained the rejections of record.

Appellants note that this Reply Brief is being filed under 37 C.F.R. 1.193(b)(1) and is directed to the arguments presented in the Examiner's Answer. With regard to this Reply Brief, Appellants note that they are addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT**First Issue**

On the Page 4, section 10 (*Grounds of Rejection*), the Examiner asserts that "[i]t would have been obvious to employ a pressure of 2.5MPa in light of the Schiel disclosure,"

(Examiner's Answer Page 4, second full paragraph), since the 2.5 MPa disclosed by Schiel is about the 2 MPa pressure recited in Appellants' claims. While noting that the term "about" is not expressly defined, the Examiner asserts that, as an embodiment of the invention discloses a pressure of 3.3 MPa, "it is reasonable to conclude that 'about' 2 MPa includes 3.3 MPa." Appellants submit that the Examiner's arguments are based upon an misunderstanding/misinterpretation of Appellants' disclosure.

In particular, Appellants note that the original disclosure was directed to two specific embodiments, i.e., a long shoe exerting a low pressure and a short shoe exerting a high pressure. More specifically, Appellants note that the long shoe/low pressure embodiment, to which the instant invention is directed, relates to a shoe having a length *greater than* 80 mm and a *maximum pressure* of less than or equal to 2 MPa, whereas the short shoe/high pressure embodiment relates to a shoe having a length *less than* 60 mm and a *maximum pressure* of greater than or equal to 3.3 MPa. (See Specification paragraphs [0029] and [0030]).

Thus, Appellants note that two distinct embodiments of the invention are disclosed, that there is no suggestion that the disclosed low maximum pressure of less than or equal to about 2 MPa is *about* the disclosed high maximum pressure of greater than or equal to 3.3 MPa. In fact, Appellants submit that the original disclosure makes clear that these pressures are certainly not about the same, such that the Examiner's arguments are based upon a misinterpretation of Appellants' disclosure.

Accordingly, contrary to the Examiner's assertions, Appellants submit that it would not have been "reasonable to conclude that 'about' 2 MPa includes 3.3 MPa." Thus,

Appellants submit that the Examiner's basis for asserting that 2.5 MPa is "about" 2 MPa is improper, and that the rejection should be reversed.

Further, as Appellants have previously noted, neither Appellants' disclosure nor any of the art of record provides any teaching to suggest to one ordinarily skilled in the art that, in the context of the invention of Schiel, that Schiel's disclosed *minimum* pressing pressure of 2.5 MPa is "about" the same as a *maximum* pressing pressure of less than or equal to about 2 MPa, as recited in Appellants' claims.

In this regard, Appellants submit that, as the *minimum* pressure of 2.5 MPa in SCHIEL would have to be decreased by 20% to correspond to the *maximum* pressure recited in the pending claims, Appellants submit that there is no suggestion to one skilled in the art that the "minimum" maximum pressure of 2.5 MPa disclosed by SCHIEL is "about" 2.0 MPa. Moreover, Appellants submit that the art of record fails to provide any teaching or suggestion that reducing the maximum pressure of SCHIEL to about 2 MPa would enable SCHIEL to continue operating in its intended manner, such that the asserted modification would not have been obvious under 35 U.S.C. §103(a).

Moreover, while SCHIEL indicates that the above-noted range (having a minimum pressure of 2.5 MPa) is advantageous "if a high production capacity is what is sought," Appellants note that SCHIEL fails to provide any teaching or suggestion as to what parameters, if any, would require adjustment if high production capacity is not sought. While the Examiner has asserted that it would have been obvious that, if high production capacity is not sought, one would reduce the pressure to 2.0 MPa or below, there is no teaching or

suggestion in the art of record to support the Examiner's assertions. In fact, Appellants note that SCHIEL fails to provide any teaching or suggestion of operation outside of the disclosed range of greater than 2.5 MPa, and certainly fails to suggest operating the press at a pressure significantly below, i.e., 20% below, the lowest disclosed limit of the range.

Appellants further note that, because SCHIEL provides no guidance for operating outside of the disclosed pressure range of greater than 2.5 MPa, this document does not provide any disclosure as to what output one could expect if operated within the modified range asserted by the Examiner, and certainly provides not suggestion that operation within such a range would successfully dewater the web to the extent necessary in SCHIEL.

Accordingly, Appellants submit that, as the Examiner's asserted modification of SCHIEL is contrary to express teachings of the document, it is not apparent that the lower maximum pressing pressure would be sufficient to enable the press of SCHIEL to operate in its intended manner.

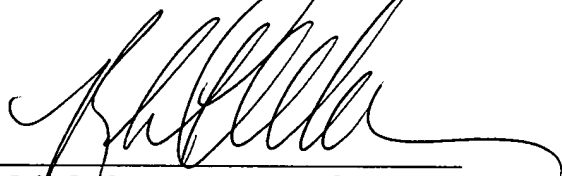
For the foregoing reasons, Appellants submit that SCHIEL fails to teach or suggestion the combination of features recited in at least the independent claims, such that the Examiner's decision to finally reject the claims should be reversed and the application should be remanded to the examining group for early allowance.

CONCLUSION

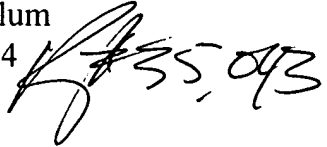
For the reasons expressed above, Appellant respectfully requests that the grounds of rejection advanced by the Examiner be reversed. Appellants further request that the application be returned to the Examining Group for prompt allowance.

Although neither a fee nor an extension of time is believed to be due with this Reply Brief, if an extension of time is necessary, Appellants respectfully request an extension of time under 37 C.F.R. 1.136(a) for as many months as would be required to render this submission timely. Further, the Commissioner is hereby authorized to charge any additional fee due to Deposit Account No. 19-0089.

Respectfully submitted,
Thomas THORÖE SCHERB et al.



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October 12, 2004
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